

BS01286

U.S. Application No. 10/026,704 Art Unit 2661  
Response to March 20, 2006 Office Action

### **REMARKS**

In response to the Office Action dated March 20, 2006, the Assignee respectfully requests reconsideration based on the above amendments and the following remarks. The Assignee respectfully submits that the pending claims distinguish over the cited documents.

Claims 19-31 are pending in this application. Claims 1-18 have been cancelled.

Claims 1-2, 6-8, 10, 15-16, 18-23, 25-26, and 30 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,128,033 to Friedal *et al.* Claims 3-5, 9, 11-14, 21, 24, 27, and 31 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Friedal* in view of Published U.S. Patent Application 2005/0251827 to Ellis *et al.*

The Assignee shows, however, that the pending claims are neither anticipated nor obviated. The Assignee thus respectfully submits that the pending claims distinguish over *Friedal* and *Ellis*.

### **Telephone Interview with Examiner Van Handel**

Examiner Van Handel discussed this response. A telephone interview was held Monday, June 5<sup>th</sup>, between Examiner Van Handel and Scott Zimmerman. Examiner Van Handel agreed that the amended claims distinguish over the cited documents to *Friedal* and *Ellis*. Examiner Van Handel then suggested this response be formally submitted.

### **Rejection of Claims Under 35 U.S.C. § 102 (e)**

Claims 1-2, 6-8, 10, 15-16, 18-23, 25-26, and 30 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,128,033 to Friedal *et al.* A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also*

BS01286

U.S. Application No. 10/026,704 Art Unit 2661  
Response to March 20, 2006 Office Action

DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P.").

First, claims 1-18 have been canceled. The s 102 (e) rejection of claims 1-2, 6-8, 10, 15-16, and 18 is thus moot.

Claims 19-23, 25-26, and 30 are not anticipated. These claims recite, or incorporate, features not disclosed by *Friedal*. Independent claim 19, for example, recites "*a first input receiving an audio signal*" and "*a second input adapted to receive audible message information.*" The "*volume of the audio signal is reduced below a volume of the audible message information.*" Support for such features may be found at least at paragraph [0050] of the as-filed application. Moreover, independent claim 19 also recites "*a back channel communications path that is different from the first input.*" Support for such features may be found at least at paragraphs [0025] and [0026] of the as-filed application. Independent claim 19 is reproduced below, and independent claim 30 recites similar features.

19. A set top box integrated with, or communicating with, a television, the set top box comprising:

a first input receiving an audio signal;  
a first output adapted to be received by the television;  
a second output adapted to be received by a second set top box;  
a second input adapted to receive audible message information from a user; and  
a back channel communications path that is different from the first input,  
wherein a volume of the audio signal is reduced below a volume of the audible  
message information.

*Friedal* cannot anticipate the claims. The patent to *Friedal et al.* is completely silent to the "*volume of the audio signal is reduced below a volume of the audible message information.*" Moreover, *Friedal* fails to disclose "*a back channel communications path that is different from the first input.*" Because the patent to *Friedal et al.* is completely silent to at least these features,

BS01286

U.S. Application No. 10/026,704 Art Unit 2661  
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*Friedal* cannot anticipate the claims. The Assignee thus respectfully requests removal of the § 102 (e) rejection of claims 19-23, 25-26, and 30.

*Friedal* is additionally silent to other claimed features. Claim 22 recites “*audio content is processed for an audio channel and the audible message information is processed for another audio channel.*” Support for such features may be found at least at paragraph [0050] of the as-filed application. Claims 23 and 25 recite features for “*pre-made voice messages.*” Support for such features may be found at least at paragraphs [0037] and [0040] of the as-filed application. Claim 26 recites a “*message waiting indicator,*” and support may be found at least at paragraph [0038] of the as-filed application. Claim 28 recites “*wherein the first input also receives a video signal and the set top box modifies the video signal to display a text message.*” Support for such features may be found at least at paragraph [0045] of the as-filed application. Claim 29 recites “*wherein the audio signal is processed for an audio channel and the audible message information is processed for another audio channel.*” Support for such features may be found at least at paragraph [0050] of the as-filed application.

Claims 19-23, 25-26, and 30, then, are not anticipated. The patent to *Friedal et al.* is completely silent to many features recited in these claims. Because the patent to *Friedal et al.* fails to disclose so many claimed features, *Friedal* cannot anticipate the claims. The Assignee thus respectfully requests removal of the § 102 (e) rejection of claims 19-23, 25-26, and 30.

#### **Rejection of Claims Under 35 U.S.C. § 103 (a)**

Claims 3-5, 9, 11-14, 21, 24, 27, and 31 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Friedal* in view of Published U.S. Patent Application 2005/0251827 to Ellis *et al.* If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires “some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill”; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be

BS01286

U.S. Application No. 10/026,704 Art Unit 2661  
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taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P.").

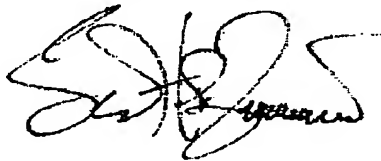
First, claims 1-18 have been cancelled. The rejection of claims 3-5, 9, and 11-14 is thus moot.

Claims 21, 24, 27, and 31 are not obvious. These claims are all dependent upon their respective base claim and, thus, incorporate the same distinguishing features. No where, for example, does the proposed combination of *Friedal* and *Ellis* teach or suggest the "*volume of the audio signal is reduced below a volume of the audible message information.*" Moreover, *Friedal* and *Ellis* fails to disclose "*a back channel communications path that is different from the first input.*" One of ordinary skill in the art, then, would not find it obvious to modify the teachings of *Friedal* and *Ellis* to obviate claims 21, 24, 27, and 31. Because the proposed combination of *Friedal* and *Ellis* does not teach or suggest all the claimed features, the § 103 rejection of these claims must be removed.

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If any questions arise, the Office is requested to contact the undersigned at (919) 387-6907 or [scott@scottzimmerman.com](mailto:scott@scottzimmerman.com).

Respectfully submitted,



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